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William M. Lee, Jr.
LEE MANN SMITH McWILLIAMS SWEENEY & OHLSON
P.O. Box 2786
Chicago, IL 60690-2786

In re Application of
PLOUG, Ole et al
U.S. Application No.: 09/000,008
PCT No.: PCT/DK96/00302
Int. Filing Date: 04 July 1996
Priority Date: 15 July 1995
Attorney's Docket No.: 196-1142
For: AXIAL PISTON MICROPUMP

DECISION

This decision is in response to applicants' "Petition Under 37 C.F.R. §1.137 with Accompanying Petition Under 37 C.F.R. §1.182" ("Pet.") and "Petition to the Commissioner Pursuant to 37 C.F.R. §1.182" filed on 12 October 1999 and applicants' "Status Inquiry and Request for Decision on Petition" filed 15 October 2001.

BACKGROUND

On 26 August 1999, a decision dismissing applicants' "Request for Withdrawal of Notification of Abandonment" filed 22 March 1999 and "Request for Reconsideration of Decision on Request and Notification" filed 24 December 1998 was mailed. Since the application was deemed still abandoned, applicants' request under 37 CFR 1.182 and 1.183 was not considered.

On 12 October 1999, applicants filed a petition under 37 CFR 1.137 and a petition under 37 CFR 1.182.

On 15 October 2001, applicants submitted a status inquiry along with copies of the documents filed 12 October 1999..

DISCUSSION

Petition Under 37 CFR 1.182

Applicants petition the Commissioner to accept the name change of Jakob Bogh Poulsen to Jakob Bogh Schubert. Applicants provided the \$130.00 petition fee. Section 605.04(c) of the Manual of Patent Examining Procedure (MPEP) states, in part:

In cases where an inventor's name has been changed after the application has been filed and the inventor desires to change his or her

name on the application, he or she must submit a petition under 37 CFR 1.182. . . . The petition must include an appropriate petition fee and an affidavit signed with both names and setting forth the procedure whereby the change of name was effected, or a certified copy of the court order.

Applicants submitted a "Declaration of Jakob Bogh Schubert on 22 March 1999 who states in paragraph one that "[a]t the time of filing of the international application, his surname was Poulsen, and his full name was Jakob Bogh Poulsen." Then, he maintains in paragraph two that "his surname was changed to Schubert, and his full name is now Jakob Bogh Schubert. The change of his name was due to his marriage. There is no official document for this name change."

Therefore, applicants have satisfactorily met the requirements of the MPEP.

Petition Under 37 CFR 1.137(a)

A petition to revive an abandoned application on the grounds that the failure to reply was unavoidable pursuant to 37 CFR 1.137(a) must be accompanied by: (1) the required reply; (2) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; (3) any terminal disclaimer required pursuant to 37 CFR 1.137(c); and (4) the petition fee.

Applicants submitted the \$110.00 petition fee. No terminal disclaimer is required. The showing requirement of item (2) may be met by a satisfactory showing that the cause of the delay resulting in failure to reply in timely fashion to the Office action was unavoidable. See §711.03(c) of the MPEP. Applicants argue that the abandonment was unavoidable because "nothing in MPEP 605.04(c) explains that if an inventor signs an application with his or her new name, that could lead to abandonment of the application. Indeed, nothing that has been found in the Manual of Patent Examining Procedure which explains that such a result would occur, particularly when the inventor properly signed the application with his new name, and indicated that it was a change of name. While applicants could expect that an appropriate petition to accept the name change would need to be filed, nothing in the Manual of Patent Examining Procedure or rules would suggest potential abandonment of the application in this situation." Pet. ¶ 7.

This argument has been considered and rejected.

A Notification of Missing Requirements was mailed by the United States Designated/Elected Office (DO/EO/US) in the above-captioned application on 16 March 1998. The Notification clearly indicated that a declaration meeting the requirements of 37 CFR 1.497 was required. Applicants were given one month to properly respond with

extensions of time available under 37 CFR 1.136(a). Applicants responded with a declaration that did not meet the requirements of 37 CFR 1.497(a)(3) because one of the co-inventors signed the declaration with a different name than was listed on the underlying international publication on 26 March 1998.

Accordingly, the DO/EO/US mailed a Notification of Defective Response and Notification of Defective Oath or Declaration on 26 May 1998 indicating that the declaration did not properly identify the inventors. In the Notification of a Defective Oath or Declaration in capital letters, it states that:

**FAILURE TO SUBMIT AN OATH OR DECLARATION IN COMPLIANCE
WITH 37 CFR 1.497(a) AND (b) WITHIN THE TIME PERIOD SET WILL
RESULT IN FAILURE TO ENTER THE NATIONAL STAGE AND THE
ABANDONMENT OF THE APPLICATION.**

The time period in the Notification of a Defective Response gave applicants one month or the time remaining in the Notification of Missing Requirements, whichever is longer, to respond. Applicants answered with a petition under 37 CFR 1.181 requesting withdrawal of the Notification of Defective Response on 15 June 1998 and 29 June 1998. However, the decision dated 09 December 1998 rejected applicants petition and declared that the above-captioned application was abandoned for failure to file a timely and complete response to the Notification mailed on 16 March 1998. A request for reconsideration was dismissed on 26 August 1999.

Applicants argue that there is nothing in the MPEP that would indicate a potential abandonment in this situation. This is incorrect. 37 CFR 1.135 (a) states that "[i]f an applicant of a patent application fails to reply within the time period provided under §1.134 and §1.136, the application will become abandoned unless an Office action indicates otherwise. A proper response to the Notification of a Defective Response was a petition under 37 CFR 1.182 to change the name of the inventor so that the declaration complies with 37 CFR 1.497. Applicants failed to provide this response in a timely manner. Section 711.03(c) states, in part that "[d]elay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP, however, does not constitute "unavoidable" delay."

Accordingly, applicants do not meet the requirements of 37 CFR 1.137(a).

Petition Under 37 CFR 1.137(b)

In the instant petition, applicants state that "the abandonment of the application clearly falls within the unavoidable basis for revival of the application, if the Patent and Trademark Office determines otherwise, it is requested that this petition be considered under 37 C.F.R. §13(b)[sic] as being unintentional.

A grantable petition pursuant to this paragraph must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee; (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional; and (4) any terminal disclaimer required.

The statement that "[t]he entire delay until the filing of a grantable petition was, and remains unintentional" has been interpreted as meaning that the "entire delay in filing the required reply from the due date for the reply until the filing of this petition under 37 CFR 1.137(b) was unintentional" as required by 37 CFR 1.137(b)(3). If this is an incorrect interpretation, applicants are requested to notify this office. The petition fee of \$1,280.00 has been charged to counsel's Deposit Account No. 12-0913 as authorized. No terminal disclaimer is required.

Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

CONCLUSION

Applicants' petition under 37 CFR 1.182 to accept the name change of a co-inventor is GRANTED.

For the reasons listed above, applicants' petition under 37 CFR 1.137(a) is DISMISSED without prejudice. But applicants' petition under 37 CFR 1.137(b) is GRANTED.

Upon granting applicants' request to accept the name change of Jakob Bogh Schubert, the declaration submitted on 26 March 1998 now complies with 37 CFR 1.497. Applicants have completed the requirements for acceptance under 35 U.S.C. § 371(c). The application has an international filing date of 04 July 1996, under 35 U.S.C. 363, and a 35 U.S.C. 371(c) date of 26 March 1998.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.



Leonard Smith
PCT Legal Examiner
PCT Legal Office



James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457